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IN THE

Supreme Court of the United States

OCTOBER TERM, 1952

No. 601

RANDOLPH LABORATORIES, INC.,

Petitioner,

v.

SPECIALTIES DEVELOPMENT CORPORATION,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

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TO THE HONORABLE, THE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioner, RANDOLPH LABORATORIES, INC., respectfully prays for a Writ of Certiorari to the United States Court of Appeals for the Third Circuit to review an order of that court entered on November 13, 1952, denying a petition for leave to file a motion in the District Court to set aside the judgment sustaining a reissued patent in the above entitled case on the ground that the reissue was obtained by a fraud practiced on the Patent Office. A motion for reconsideration of this order was denied without opinion on January 6, 1953.

Opinion Below

The opinion of the Court of Appeals for the Third Circuit affirming the judgment sustaining the patent is reported in 178 F. 2d 477. A supplemental opinion modifying the judgment in certain minor particulars is reported in 185 F. 2d 403. The opinion of the Court of Appeals denying the petition for leave to file a motion to reopen is reported in 199 F. 2d 680.

Jurisdiction

The jurisdiction of this court is invoked under 28 U. S. C. Section 1254(1) and under Rule 38(5)(b) of the rules of this court.

Statement

On April 30, 1945 plaintiff, Randolph Laboratories, Inc., brought suit for declaratory judgment asking that a patent, No. 1,760,274 directed to a portable fire extinguisher, be declared invalid and not infringed by fire extinguishers then being manufactured by plaintiff. On November 28, 1945 defendant in that action filed a counterclaim alleging infringement by plaintiff of three other patents owned by defendant, one of such patents being the Mapes Reissue Patent No. 18,839 with which we are here concerned. This patent was originally granted with fourteen claims. It was reissued by respondent* on the ground that the original claims did not adequately cover the invention, and three broader claims, 15, 16 and 17 were obtained.

The Mapes reissue patent was held valid and infringed as to claim 16, and an accounting to determine damages was ordered. The other patents in suit were held invalid

* The named defendant in this action is a wholly owned patent holding subsidiary of Walter Kidde & Co., Inc., who filed the reissue and is the real party in interest.

or not infringed. Upon appeal to the Court of Appeals for the Third Circuit the decree of the lower Court was affirmed (R. 57, *et seq.*).

In the course of the trial reference was made to a fire extinguisher alleged to have been developed, or at least experimented with, by a company known as the Fyre-Freez Company, which company had been purchased by the respondent and its business absorbed by respondent. Although plaintiff argued that in view of the Fyre-Freez device and a prior patent to one Campbell the reissue patent was devoid of invention, no reference was made to that device in the findings or opinion of the lower Court or the Court of Appeals, but instead claim 16 was held valid over the Campbell patent which was stated to be the only pertinent prior art.

The subject-matter of the patent in suit is a fire extinguisher consisting of a heavy metal cylinder containing compressed carbon dioxide gas. The internal pressure is very high and in use the gas is discharged onto the fire through a pressure reducing orifice in the discharge hose. When all the gas is used up the cylinders are recharged, which is accomplished by removing the discharge hose and attaching a hose from the storage tank containing the carbon dioxide under pressure. If the recharging hose is detached from the fire extinguisher without first closing the valve of the fire extinguisher, the discharge of gas through the open outlet will cause a violent recoil of the cylinder, with the likelihood of injury to persons and property. To prevent this recoil the patentee placed in the outlet opening an anti-recoil device arranged so that the outlet hose of the extinguisher and the recharging hose could be attached thereover without removing the anti-recoil device. This structure is covered broadly by claim 16 obtained by reissue of the patent in 1933.

> "16. The combination with a high pressure gas container and gas release device therefor, of a recoil

preventing safety device arranged to have a conducting means attached thereover to permit the delivery of gas to the conducting means from the container without the necessity of removing the recoil preventing device."

The Campbell patent discloses the same sort of anti-recoil device, namely, a so-called diffusion tip, applied to a cylinder of compressed gas but not so arranged that the recharging hose can be attached to the cylinder without removing the anti-recoil device. The Fyre-Freez extinguisher was equipped with an anti-recoil device in the discharge outlet so arranged that the discharge hose and the recharging hose could be attached thereover without removing the anti-recoil device. The particular anti-recoil device employed in the Fyre-Freez extinguisher is a ball check valve which is held open when the discharge hose or recharging hose is attached and is closed by the gas pressure when the hose is removed.

Before the master in the accounting proceedings defendant urged that the invention of the Mapes patent was a basic patent which dominated the use and salability of fire extinguishers. To meet this contention plaintiff conducted an investigation of the development of the carbon dioxide fire extinguishers and the structure of the fire extinguishers available to the public prior to the patent in suit.

In this investigation plaintiff located two former employees of the Fyre-Freez Company who were called as witnesses before the master. These witnesses testified that the Fyre-Freez structure was successfully marketed over a period of several years prior to the purchase of that company by respondents; that thousands of the extinguishers were sold and that the extinguisher had been approved by the fire underwriters, the U. S. Government, the City of New York, and by a number of large industrial concerns.

The witnesses also testified that the full particulars of the Fyre-Freez valve with its anti-recoil device and the operations of the Fyre-Freez Company were fully disclosed to defendant's agents prior to and during the negotiations which led to the purchase of the Fyre-Freez Company by defendant.

One of these witnesses produced a specimen of the Fyre-Freez valve as manufactured and sold by that company. There was also produced a sales manual used by the salesmen of that company.

This exhibit valve and the documents included in the sales manual make it plainly apparent that claim 16, which is the only claim in the patent found to be infringed by plaintiff's extinguisher, is of such broadened scope as to be fully anticipated by the Fyre-Freez valve.

Before the master it was urged that claim 16 would not have been allowed had the patent Examiner been advised of the Fyre-Freez structure; that the claim had been obtained by fraud and no award of damages should be made. The master declined to consider this issue of fraud on the ground that the order directing the accounting limited the issue before him to the single question of the amount of damages to be awarded.

Petitioner thereupon presented to the United States Court of Appeals for the Third Circuit a petition (R. 1). for leave to file in the District Court a motion to set aside the interlocutory judgment, to amend the pleadings, to set up the defense of estoppel to enforce the patent because of the fraud in obtaining it, and for such other and further relief as might be equitable. Plaintiff offered with the petition the sample of the original Fyre-Freez valve presented at the accounting proceedings and also the sales manual covering that device, in order to show the Court of Appeals the nature of the evidence which plaintiff sought leave to offer in the District Court.

The petition for leave to reopen was denied by the Court of Appeals for the Third Circuit, their reasons for the denial being set forth in an opinion handed down on November 13, 1952 (R. 26, *et seq*). The ground of that refusal to reopen is that:

> "It was, and still is, our view that the nature of the 'recoil preventing safety device' of claim 16 of the Mapes Reissue Patent must be regarded as defined by the Specification of the patent and as limited to the type of device therein described, namely, one which without hindering the escape of gas so diffuses its flow as to prevent recoil. So limited the claim does not read upon a device, such as the Fyre-Freez valve, whose nonrecoil safety feature consists merely of a check valve which stops the escape of gas. It follows, as both the district court and this court have heretofore held, that the Fyre-Freez valve did not anticipate the subject matter of claim 16. Mapes was, therefore, not guilty of fraud in not disclosing to the Patent Office the prior use of that device" (R. 32).

The Court of Appeals, however, stated that:

> "Nonetheless if we thought that there was any probability that Mapes or his assignee, defendant Walter Kidde & Company, Incorporated, had been guilty of fraud in procuring the allowance of claim 16 we would not hesitate to grant the plaintiff the leave which it now requests" (R. 29).

Believing that the ruling of the Court of Appeals denying leave to present the motion to reopen the proceedings of the District Court was due to lack of familiarity with the Patent Office procedure, the petitioner filed a second motion (R. 33) for leave to present its proposed motion to reopen in the District Court, that motion being supported by an affidavit of Mr. Porter, a former Ex-

aminer-in-Chief in the Patent Office (R. 37), who stated categorically that had the public use and the sale of the Fyre-Freez structure* been called to the attention of the Examiner before whom the reissue was pending, it would have been his duty to require such amendment to claim 16 as would expressly exclude the Fyre-Freez structure from its scope, and that such Examiner might, in fact, have refused to allow any additional claims on the ground that no invention was involved in substituting one old form of anti-recoil device for another in a fine extinguisher structure otherwise old.

Plaintiff's second motion was denied without opinion (R. 56).

The Fyre-Freez valve and sales manual have been certified to this Court by the Court of Appeals for the Third Circuit to accompany this petition.

The Questions Presented

1. Is not the assignee of a granted patent applying for a reissue to broaden the claims of that patent, guilty of a fraud on the Patent Office in failing to disclose to the Patent Office the known prior manufacture and sale by a company, which it later absorbed, of a device of the same kind and within the scope of the broadened claim, to thereby avoid consideration by the Patent Office of such prior art and the risk of refusal of the Patent Office to grant the broadened claim?

2. Is it not the duty of a Court of Appeals which has affirmed an interlocutory judgment sustaining the validity of a patent claim, to reopen upon a *prima facie* showing that said claim was obtained by a fraud practiced on the

* Mr. Porter refers to Minor patent No. 1,879,397 as showing the Fyre-Freez structure. The application for this patent was filed after respondent bought up the Fyre-Freez Company on an application too late to be prior art to the patent in suit.

Patent Office, to grant leave to the aggrieved party to submit to the District Court its evidence of the alleged fraud?

3. Is it not a fraud on the Patent Office to seek, through reissue, a broadened claim which reads on a structure well known by the applicant and his assignee to have been used and sold in the United States more than two years prior to the applicant's original application?

4. Is the assignee of a reissue patent who procured its reissue without disclosing a relevant prior art structure well known to the applicant and assignee entitled to a beneficial rule of construction validating a broadened reissue claim after having asserted said broad claim against the public for the entire life of the patent?

Reasons Relied on for Allowance of the Writ

I.

The questions presented by the petition are of grave public importance involving the administration of the Patent Laws of the United States.

II.

The decision of the Court of Appeals is in conflict with the decision of this court in *Precision Co.* v. *Automotive Co.*, 324 U. S. 806 (1945).

III.

The decision of the Court of Appeals is in conflict with the decision of this court in *Hazel-Atlas Co.* v. *Hartford Co.*, 322 U. S. 238 (1944).

IV.

The decision of the Court of Appeals is in conflict with the decision of this court in *Marconi Wireless Co. v. U. S.*, 320 U. S. 1 (1943).

V.

The Court of Appeals has so far departed from usual and accepted judicial procedure as to warrant the exercise of this Court's power of supervision.

I.

The proper administration of the patent laws require that the error of the Court of Appeals be corrected. The Court of Appeals in its decision has found *affirmatively* that because the broadened claim deliberately obtained by the reissue may be sustained as valid by reading into it limitations to the particular type of anti-recoil device disclosed in the specification, the reissue applicant is excused from his failure to disclose to the Patent Office that the subject-matter of claim 16 without such limitations was in the public domain prior to the alleged invention of said subject-matter. *To sustain this ruling of the Court of Appeals for the Third Circuit is to place a premium on deception and give a reward for silence where there is a plain duty to speak.*

As set forth in the supporting affidavit of Mr. Porter (R. 37), a retired Examiner-in-Chief of the Patent Office, the purpose of the examining system of the Patent Office is to avoid the issuance of patents containing claims which by their express terms embrace within their scope structures already in the public domain. Before the Patent Office there is no occasion to construe claims by reading into them limitations based on the specifications but not

expressed in the claims themselves. It is the *duty* of the patent Examiner to reject claims which do not in themselves define patentable invention, and to require that such claims be so amended that *by their own terms* they are limited to features of inventive novelty disclosed in the specification.

The failure of the patentee to advise the patent Examiner at the time the reissue application was filed, of the unpatented Fyre-Freez structure resulted in the grant of a patent containing a claim which dominated the fire extinguisher art and precluded anyone from manufacturing the old Fyre-Freez structure and also from using any other form of anti-recoil device in the outlet passage of the fire extinguisher.

The statutes (35 U. S. C. 251) provide that a reissue application shall comply in all respects with the requirements of an original application, and one of the requirements of an original application is that the applicant shall make oath that he verily believes himself to be the original and first inventor of that for which he solicits a patent (35 U. S. C. 115). It was not intended that such oaths be made with mental reservations that the broad claims presented include by implication language not expressed therein. On the contrary, the purpose of the oath is to place upon the applicant the duty of *limiting* the claims presented to *exclude* what he knows to be already in the public domain. The required oath accompanied the present reissue application (R. 52). It was executed by the applicant, and the application was prepared by Mr. Carson, a patent solicitor employed in the Patent Department of Walter Kidde & Co. and who was so employed at the time said company acquired the Fyre-Freez Company. It is beyond belief that Mr. Carson did not know when he presented claim 16 that it covered the old Fyre-Freez structure whose manufacture had by that time been discontinued by Walter Kidde & Co. and that if said claim was obtained

through the ignorance of the Patent Office of that prior device it would preclude any competitor of Walter Kidde from installing any form of anti-recoil device in the outlet opening of a fire extinguisher.

II.

In *Precision Co.* v. *Automotive Co.*, 324 U. S. 806 (1945), it was specifically ruled that it was the duty of an applicant for a U. S. patent to disclose to the Patent Office all relevant facts so that the Patent Office may pass upon their significance. In that case the applicant in question was involved in interference proceedings. He discovered evidence which led him to believe that his adversary had established his date of invention by false evidence, but the evidence did not in the opinion of his counsel furnish adequate legal proof of that fact. Instead of revealing these facts to the Patent Office he settled the interference by agreement with his adversary under which the patents were allowed to issue without revealing the factual situation. The patents so secured were held not enforceable—not upon proof establishing the invalidity of the patents, but because the *applicant had failed to reveal to the Patent Office* the relevant facts on which the Patent Office could decide that question.

> "• • • Those who have applications pending with the Patent Office or who are parties to Patent Office proceedings have an uncompromising duty to report to it all facts concerning possible fraud or inequitableness underlying the applications in issue. Cf. *Crites, Inc.* v. *Prudential Co.*, 322 U. S. 408, 415. This duty is not excused by reasonable doubts as to the sufficiency of the proof of the inequitable conduct nor by resort to independent legal advice. Public interest demands that all facts relevant to such matters be submitted formally or informally to the Patent Office, which can

> then pass upon the sufficiency of the evidence. Only in this way can that agency act to safeguard the public in the first instance against fraudulent patent monopolies. Only in that way can the Patent Office and the public escape from being classed among the 'mute and helpless victims of deception and fraud.' *Hazel-Atlas Glass Co.* v. *Hartford-Empire Co., supra,* 246." (*Precision Co.* v. *Automotive Co.,* 324 U. S. 806, 818.)

The facts there are closely parallel to those presented here. If the applicant for the reissue of the Mapes patent may possibly be assumed to have acted honestly in presenting claim 16 on the theory that it could be sustained by reading into it the particular form of anti-recoil device disclosed in the specification, it was nevertheless their duty to disclose to the Patent Office the Fyre-Freez structure and *let the Patent Office decide* what limitations should be included in claim 16 in order for it to be patentable over the Fyre-Freez device.

III.

The decision of the Court of Appeals here is in direct conflict with the decision of this Court in *Hazel-Atlas Co.* v. *Hartford Co.,* 322 U. S. 238 (1944). In that case this Court laid down as an inflexible rule that where deception is practiced in the procedure before the Patent Office leading to the grant of a patent, that patent will not be enforced. The fraud there was of the same character as practiced here. There was a direct deception of the Patent Office as to the scope of the alleged invention sought to be patented. In that case the applicant for the patent in question filed with the Patent Office an article purportedly written by an official of the Glass Workers Union when in fact the article had been written by the at-

torney for the applicant who had procured its publication over the signature of the Union official by paying the latter a fee. Upon this apparent endorsement of the invention by one skilled in the art the patent was allowed. Although the facts stated in the article were true and the invention did in fact have the merits ascribed to it, this Court nevertheless held that the procurement of the patent by this misrepresentation vitiated the entire proceedings.

"The question remains as to what disposition should be made of this case. Hartford's fraud, hidden for years but now admitted, had its genesis in the plan to publish an article for the deliberate purpose of deceiving the Patent Office. The plan was executed, and the article was put to fraudulent use in the Patent Office, contrary to law. U. S. C. Title 35, § 69; *United States* v. *American Bell Telephone Co.*, 128 U. S. 315. From there the trail of fraud continued without break through the District Court and up to the Circuit Court of Appeals. *Had the District Court learned of the fraud on the Patent Office at the original infringement trial, it would have been warranted in dismissing Hartford's case.* In a patent case where the fraud certainly was not more flagrant than here, this Court said: 'Had the corruption of Clutter been disclosed at the trial * * *, the court undoubtedly would have been warranted in holding it sufficient to require dismissal of the cause of action there alleged for the infringement of the Downie patent.' *Keystone Driller Co.* v. *Excavator Co.*, 290 U. S. 240, 246; cf. *Morton Salt Co.* v. *G. S. Suppiger Co.*, *supra*, 493, 494. So, also, could the Circuit Court of Appeals have dismissed the appeal had it been aware of Hartford's corrupt activities in suppressing the truth concerning the authorship of the article. The total effect of all this fraud, practiced both on the Patent Office and the courts, calls for nothing less than a complete denial of relief to Hartford for the claimed infringement of

the patent thereby procured and enforced." (Emphasis added.) *Hazel-Atlas Co.* v. *Hartford Co.*, 322 U. S. 238, 250.

"* * * Neither should they now be permitted to escape the consequences of Hartford's deceptive attribution of authorship to Clarke on the ground that what the article stated was true. Truth needs no disguise. The article, even if true, should have stood or fallen under the only title it could honestly have been given—that of a brief in behalf of Hartford, prepared by Hartford's agents, attorneys, and collaborators." (*Hazel-Atlas Co.* v. *Hartford Co., supra,* p. 247.)

IV.

The ruling of the Court of Appeals in denying the petition for leave to file a motion to set aside the interlocutory judgment in the lower Court and the consideration by that Court of the issue of fraud which the master refused to consider because outside the scope of his order, is directly contrary to the rule of this Court in *Marconi Wireless Co.* v. *U. S.*, 320 U. S. 1 (1943). The facts in the *Marconi* case are directly on all fours with those presented here, except that the issue sought to be raised before the master was not an issue of fraud but merely an issue of infringement. In that case matters arose in the accounting proceeding which constituted *prima facie* evidence of non-infringement. The Court of Claims refused to consider the evidence presented before the master. This Court, however, reversed the ruling of the Court of Claims and held that the fact that counsel for the Government had failed at the trial of the case to press the claim of non-infringement did not justify the refusal of that Court to set aside the interlocutory decree and consider the question of infringement raised before the master which the master stated, correctly, was outside the scope of his order.

The petition before the Third Circuit Court of Appeals did not ask that the proceedings be reopened, but merely sought leave to file a motion to reopen the decree in the District Court. As found by this Court in the *Marconi* case, the question whether the interlocutory decree should be set aside and modified or reversed were "all matters requiring careful consideration by the *trial Court*" (emphasis added).

> "Although the interlocutory decision of the Court of Claims on the question of validity and infringement was appealable, *United States* v. *Esnault-Pelterie,* 299 U. S. 201, 303 U. S. 26; 28 U. S. C. § 288(b), as are interlocutory orders of district courts in suits to enjoin infringement, 28 U. S. C. § 227(a); *Simmons Co.* v. *Grier Bros. Co.,* 258 U. S. 82, 89, the decision was not final until the conclusion of the accounting. *Barnard* v. *Gibson,* 7 How. 649; *Humiston* v. *Stainthrop,* 2 Wall. 106; *Simmons Co.* v. *Grier Bros. Co., supra,* 89. Hence the court did not lack power at any time prior to entry of its final judgment at the close of the accounting to reconsider any portion of its decision and reopen any part of the case. *Perkins* v. *Fourniquet,* 6 How. 206, 208; *McGourkey* v. *Toledo & Ohio Central Ry. Co.,* 146 U. S. 536, 544; *Simmons Co.* v. *Grier Co., supra,* 90-91. It was free in its discretion to grant a reargument based either on all the evidence then of record or only the evidence before the court when it rendered its interlocutory decision, or to reopen the case for further evidence.
>
> "Whether it should have taken any of these courses was a matter primarily for its discretion, to be exercised in the light of various considerations which this Court cannot properly appraise without more intimate knowledge than it has of the proceedings in a long and complex trial. Among those considerations are the questions whether, as appears to be the case from such portions of the record as have been filed

in this Court or cited to us by counsel, the Government failed to make any contention as to the validity or construction of Claim 16 in the proceedings leading to the interlocutory decision; whether the showing of non-infringement which it now makes is sufficiently strong, and the public interest that an invalid patent be not sustained is sufficiently great, to justify reconsidering the decision as to Claim 16 despite the failure of Government counsel to press its contention at the proper time; whether adequate consideration of the question of non-infringement can be had on the existing record, or whether additional testimony should be received; and whether, balancing the strength or weakness of the Government's present showing of non-infringement against the undesirability of further prolonging this already extended litigation, the case is one which justifies reconsideration.

"These are all matters requiring careful consideration by the trial court." (Emphasis added.) *Marconi Wireless Co.* v. *U. S.*, *supra*, p. 47.

V.

The action of the Court of Appeals herein finds no support in any decided case of this Court or the Courts of Appeals in the other Circuits. Claim 16 of the reissue patent was obtained for the express purpose of broadening the scope of the original patent so as to cover fire extinguishers having any form of anti-recoil device arranged in the outlet passage so that the discharge hose could be attached thereover. In sustaining the patent on that theory the Court of Appeals said:

"* * * The problem which the patent solved arose because of the tremendous pressures involved in these cylinders which will cause a recoil if the gas is permitted to escape. In such a situation the continuous pressure of the escaping gas in one direction drives

the cylinder in the opposite direction with serious danger to person and property. Campbell devised a safety cap with oppositely disposed ports on its sides through which the gas could escape, so that the recoil from each port is equal and opposite and therefore is balanced out. The difficulty with this was that the safety cap had to be removed when filling the cylinder and was frequently not replaced after the filling was over. Mapes' contribution was to show that such a safety device could be so placed that a coupling to the intake or discharge pipe could be affixed to it or placed over it and the cylinder filled or discharged through it without it being removed. This was a great advantage for it made it possible to keep the safety device in place at all times and thus make certain that it would be in place when needed'' (R. 63).

The patentee has held this broadened monopoly throughout the entire life of the patent. It is now apparent that the patentee was not entitled to this monopoly and that the subject-matter of claim 16 was already in the public domain. Yet the Court of Appeals has refused to permit the proper tribunal, to wit, the Trial Court, to consider the evidence that has been adduced in the accounting proceedings by the unwarranted procedure of re-writing by *construction* the broad claim deliberately presented in the reissue application.

The Court of Appeals based its decision on the fictitious assumptions that the claim limited by construction was presented in lieu of the actual broad claim; that it was allowed by the Patent Office as patentable over the Fyre-Freez structure—of which the Patent Office knew nothing—and that it is valid and infringed by the plaintiff.

CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

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BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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The decision below which this Court is asked to review is the one at pages 26-32 of the record, and is reported at 199 Fed. 2(d) 680.

This case was previously before this Court on Randolph's petition for certiorari as No. 698, October term, 1949. Certiorari was denied.

The questions presented in the petition are not in the case. They are based on an assumption which does not exist. The only possible question is whether as a factual matter there has been any showing or indication of fraud. The Court below, following the decisions of this Court cited and quoted in the petition, expressly held at R. 29 that if it thought there was any "probability" of fraud it "would not hesitate" to reopen the case. On the same

page it said that it was "fully satisfied" that there was no fraud. There is no conflict with any decision of this Court and no question of law.

Randolph's whole petition is based on the assumption that the Mapes patent is invalid over the Fyre-Freez valve. This is the assumption which is italicized on page 5 of the petition, stating that it is "plainly apparent". The Court of Appeals at R. 31 said it is "perfectly clear" that the assumption is erroneous.

Randolph has already argued invalidity of the Mapes patent over the Fyre-Freez valve in the Courts seven times in this case, always without success. Randolph argued invalidity of the Mapes patent over the Fyre-Freez structure at the trial (R. 17-19, ¶ 1-4), on rehearing before the Trial Court (R. 19-20, ¶ 5, 6), on appeal (R. 20-22, ¶ 7-10), on petition for certiorari to this Court in No. 698, October Term, 1949 (R. 22-24, ¶ 11), and on a second appeal to the Court of Appeals (R. 24-25, ¶ 12-13). Five years after the trial it sought leave in the Court of Appeals to reopen on the identical argument of invalidity, simply changing the name of the defense to fraud on the Patent Office (R. 1-14), and followed that with a second motion to reopen with the new label (R. 33-42). It now asks this Court to grant certiorari based on the assumption that all of these decisions were wrong.

It asks a rehearing of its petition in this same case to this Court three years ago in No. 698 for the October Term, 1949, by labelling its papers a petition for leave to reopen and attaching the dramatic and ugly label of fraud to the same defense there asserted.

The assertion in reason No. 5 (Petition, p. 9), that the Court of Appeals has departed from accepted judicial

procedure is not mentioned elsewhere in the petition. This grave charge is totally unfounded and is of a piece with the charge of fraud.

It should also be mentioned that petitioner is wrong on its fundamental fact. The Fyre-Freez structure was before the Patent Office (R. 66-68).

It is accordingly prayed that the petition be denied.

Respectfully submitted,

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SPECIALTIES DEVELOPMENT CORPORATION, *Respondent.*

REPLY BRIEF FOR PETITIONER

Respondent in its brief makes no answer to petitioner's charge that its conduct before the Patent Office in prosecuting its application upon which the reissue patent here in suit was granted constituted a fraud on the Patent Office. Instead respondent asserts that the question of fraud in obtaining the patent is to be determined *solely* by the validity of the claim obtained, and the Court of Appeals, having affirmed its finding of validity (by reading into the claim the specific anti-recoil device disclosed in the patent specification) the question of *how* the claim was obtained becomes moot.

Whether or not the respondent's conduct in obtaining its reissue in 1933 was fraudulent cannot be determined

by the construction placed upon the patent in 1949. It takes no expert to see that claim 16 of the reissue patent as obtained in 1933, without the limitation read into it in 1949, applies as well on the prior Fyre-Freez* structure as it does on the device illustrated in the reissue patent drawings. By *not* disclosing to the Patent Office the fact that the Fyre-Freez structure had been in public use and on sale more than two years prior to the filing of the application of the reissued patent, respondent obtained in its reissue patent a broad claim covering *all forms* of anti-recoil device when positioned in the discharge outlet of the extinguisher. The judgment of the Court of Appeals that the patent may be construed as valid by reading into it the specific form of anti-recoil device disclosed in the specifications of the reissued patent makes it no less a fraud to obtain a broad claim *not so limited* by concealing from the Patent Office the prior public use and sale of the Fyre-Freez structure.

The decision of the Court of Appeals as expressed in the opinion denying our petition for leave to present this issue of fraud to the District Court (R. 26-32) will encourage applicants for broadened reissues to ask for claims which they know they are not entitled to and to make the required oath that the invention defined in such claims "was not known or used before their invention or discovery thereof", with the mental reservation that the broad claim which they are asking for may, if the *concealed* prior device does come to light in some subsequent litigation, be construed as valid by reading into it the limitations *purposely omitted* in the drafting of the claim.

The practice thus tacitly approved in the opinion of the Court of Appeals for the Third Circuit will result in a grave abuse of the privileges provided by the reissue statutes and is totally inconsistent with the rulings of this Court in *Hazel-Atlas Co.* v. *Hartford Co.*, 322 U.S. 238

* The Fyre-Freez structure is illustrated in the drawing at page 47 of the record, and claim 16 appears at page 46.

(1944), and *Precision Co.* v. *Automotive Co.*, 324 U.S. 806 (1945), requiring the utmost frankness and honesty on the part of applicants for patents in their dealings with the Patent Office. In these cases this Court was not concerned with the validity of the patent obtained by concealing the true facts from the Patent Office but held that whenever pertinent facts were concealed or misrepresented in the prosecution of patent applications the patents obtained should not be enforced.

Respondent asserts (p. 3, Respondent's brief) that the Fyre-Freez structure was before the Patent Office. So it was—in a co-pending application which was not only *not* prior to the original application of the reissued patent, but was in fact filed more than two years subsequent to the public use and sale of the Fyre-Freez device. As stated in the affidavit of Mr. Porter, former Examiner-in-Chief of the Patent Office (R. 41, 42), the disclosure of a device in an application so presented constitutes "an affirmative declaration" that such device is *not* prior to the subject-matter claimed in the co-pending application.

Respectfully submitted,

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